

REMARKS

The Applicant has studied the Office Action mailed June 7, 2006 and has made amendments to the claims. Claim 3, 6, 10, 13 and 19 are amended. Claims 1, 2, 8, 9 and 15 are canceled without prejudice. No new claims are added. By virtue of this amendment, claims 3-7, 10-14 and 16-20 are pending. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested.

Objections to the Specification

The Examiner objected to the phrase "is disclosed" in the Abstract. By virtue of this Amendment, the Abstract is amended to delete the phrase to which the Examiner objected. Therefore, withdrawal of the Examiner's objection is requested.

The Examiner pointed out certain uses of trademarks in the Specification. By virtue of this Amendment, the Specification is amended to delete the trademarks to which the Examiner objected. Therefore, withdrawal of the Examiner's objection is requested.

Rejection of Claims Under 35 U.S.C. §101

The Examiner rejected claims 8-14 under 35 U.S.C. §101 because the claimed inventions are directed to non-statutory subject matter. By this amendment, claims 8 and 9 were canceled. Claim 10, which was made independent and amended to include all the limitations of claims 8 and 9, was further amended to recite, "*A computer program product executable by a computer . . .*". Therefore, amended independent claim 10 now recites statutory subject matter. Claims 11-14 depend upon claim 10, and therefore the limitation added to the preamble of amended independent claim 10 carries into the claims that are dependent on claim 10. Accordingly, withdrawal of the rejection of claims 8-14 is requested.

Rejection of Claims Under 35 U.S.C. §103(a)

The Examiner rejected claims 1, 6-8, 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Stack (U.S. Pat. No. 6,076,070), which was cited by the Applicant, in view of Cansler et al., (U.S. Pat. No. 6,725,257) hereinafter "Cansler". Reconsideration of the rejection of claims 1, 6-8, 13 and 14 is respectfully requested in view of the cancellation of claims 1 and 8, in view of the amendments to the claims, and for the following reasons.

The Applicant believes that independent claims 3 and 10 of the present invention distinguish over Stack taken alone and/or in view of Cansler for the reasons set forth hereinbelow, which are given in response to the rejection of claims 3 and 10.

Claims 6-8 and 13-14 depend from independent claims 3 and 10, respectively, and because dependent claims contain all the limitations of the independent claims, claims 6-8 and 13-14 also distinguish over Stack in view of Cansler. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

The Examiner rejected claims 2, 9, 15, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over Stack, in view of Cansler, and further in view of Mourad et al., (U.S. Pat. App. Pub. No. 2005/0010494 A1) hereinafter "Mourad". Reconsideration of the rejection of claims 2, 9, 15, 19 and 20 is respectfully requested in view of the cancellation of claims 2, 9 and 15; in view of the amendment to the claim 16; and for the following reasons.

The Examiner recited 35 U.S.C. §103. This statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole", and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole". The Stack reference in view of Cansler in view of Mourad, simply does not suggest, teach or disclose the patentably distinct limitation of:

"a processor for calculating a price for each of the plurality of configurations of the product and/or service based on the prices determined from the second web site and at least one price factor; and

a price module for adjusting the prices of each of the plurality of configurations of the product and/or service to the prices calculated by the processor, wherein the at least one price factor includes any one of:

the highest price that the market will bear for each of the plurality of configurations of the product and/or service on the first web site; and
the lowest profitable price at which the first web site can sell each of the plurality of configurations of the product and/or service ”,

as recited in the last four elements of amended claim 16. The above limitations taken “as a whole” in amended claim 16 are not present in Stack in view of Cansler in view of Mourad, taken alone or in combination.

The Federal Circuit took up the identical question of obviousness in combining references in the case *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). In that case, the Board of Patent Appeals rejected all pending claims as obvious under §103. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on “common knowledge” and “common sense”, but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. The Federal Circuit vacated and remanded. The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act. Accordingly, the Applicants respectfully suggest that the Examiner has failed to properly establish a *prima facie* case of obviousness of the invention “as a whole”.

The Applicant believes that amended independent claim 16 of the present invention distinguishes over Stack in view of Cansler in view of Mourad for at least the foregoing reason. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

Claims 19 and 20 depend from amended independent claim 16, and because dependent claims contain all the limitations of the independent claims, claims 19 and 20 also distinguish over Stack in view of Cansler in view of Mourad.

The Examiner rejected claims 3 and 10 under 35 U.S.C. §103(a) as being unpatentable over Stack, in view of Cansler, and further in view of Reuhl et al., (U.S. Pat. No. 5,873,069) hereinafter "Reuhl". Reconsideration of the rejection of claims 3 and 10 is respectfully requested for the following reasons. The combination cited by the Examiner does disclose all the following elements,

"calculating a price for each of the plurality of configurations of the product and/or service based on the prices determined from the second web site and at least one price factor; and

offering each of the plurality of configurations of the product and/or service for sale on the first web site for the calculated prices, wherein the at least one price factor includes any one of:

the highest price that the market will bear for each of the plurality of configurations of the product and/or service on the first web site; and

the lowest profitable price at which the first web site can sell each of the plurality of configurations of the product and/or service",

as recited in the last four elements of amended claim 3.

When there is no suggestion in the combination of Stack and Cansler to combine their teaching with the price factor of the Applicant's invention, such the suggestion can not come from an applicant's own specification. The Federal Circuit has repeatedly warned against using an applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP ¶2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Reuhl reference does not even suggest, teach nor mention such price factors. The Applicants respectfully suggest that the Examiner has used the Applicant's disclosure as a "blueprint" to reconstruct claim 3 out of the isolated teachings of Stack, Cansler and Reuhl.

The limitations of amended claim 10 closely parallels the limitations of amended claim 3; therefore, amended claim 10 should also be allowed for the same reasons as set forth above for amended claim 3.

Therefore, the Applicant believes that claims 3 and 10 of the present invention distinguishes over Stack in view of Cansler in view of Reuhl, taken alone or in combination, for at least the foregoing reason. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

The Examiner rejected claims 4, 5, 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Stack, in view of Cansler, in view of Reuhl et al., and further in view of Maritzen et al., (U.S. Pat. App. Pub. No. 2002/0052797 A1) hereinafter "Maritzen".

Claims 4-5 and 11-12 depend from independent claims 3 and 10, respectively, and because dependent claims contain all the limitations of the independent claims, claims 4-5 and 11-12 also distinguish over Stack in view of Cansler in view of Reuhl in view of Martizen. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

The Examiner rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Stack, in view of Cansler, in view of Mourad, and further in view of Reuhl.

The Applicant believes that claim 16 of the present invention should be allowed for at least the reasons previously stated hereinabove. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

The Examiner rejected claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Stack, in view of Cansler, in view of Mourad, in view of Reuhl, and further in view of Maritzen.

The Applicant believes that the amended independent claim 16 of the present invention should be allowed for at least the reasons previously stated hereinabove.

Claims 17 and 18 depend from amended independent claim 16, and because dependent claims contain all the limitations of the independent claims, claims 17 and 18 also distinguish over Stack, in view of Cansler, in view of Mourad, in view of Reuhl, in view of Maritzen, taken alone or in combination. Accordingly, the Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §103(a) has been overcome.

The prior art made of record and not relied upon was reviewed by the Applicant and is not considered pertinent to Applicant's disclosure.

CONCLUSION

In this Response, the Applicant has amended certain claims. In light of the Office Action, the Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, the Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

The Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

The Applicant respectfully submits that all of the grounds for rejection stated in the Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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